

### **REMARKS**

This responds to the Office Action dated March 31, 2006. Claims 1, 32, and 73 are amended. Claims 1-143 are pending.

Claims 32, 39 and 73 were objected to due to various informalities. The amendments to claims 32 and 73 address those informalities.

#### **Information Disclosure Statement**

Applicant filed an Information Disclosure Statement ("IDS") on October 24, 2005. The Examiner partially initialed the Form 1449 that accompanied this IDS. Specifically, the documents listed on the tenth page under the header "Other Documents-Non Patent Literature Documents" were not indicated as considered by the Examiner. Applicant encloses herewith a copy of the tenth page of the Form 1449 for the Examiner's reference and a copy of the date stamped returned postcard indicating that the documents were received by the USPTO. Applicant requests that the Examiner consider the documents and return a completely initialed copy of the Form 1449 with the next Official Communication.

#### **The Nonstatutory Double Patenting Rejections**

Claims 1, 8-10, 13, 32, 39-41, 44, 63-66 and 71-78 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9-10, 12-18, 21-24, and 34-40 of U.S. application Serial No. 10/862,716. Claims 1-3, 8-13, 32-34, 39-44 and 63-78 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 and 28-42 of U.S. application Serial No. 10/890,825. Claims 1-3, 8-10, 13, 32-34, 39-41, and 71-75 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 13 and 15-18 of U.S. application Serial No. 11/220,397. Claims 1-3, 8-9, 13, 32-34, 39-40, 44, 63-64 and 71-75 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 11-13 and 16-17 of U.S. application Serial No. 11/276,077. These rejections are respectfully traversed.

Claims 1, 9-10, 12-18, 21-24, and 34-40 in the '716 application and claims 1-3, 8-13, 32-34, 39-44 and 63-78 in the '825 application do not provide a gene regulatory signal delivery

device that emits a regulatory signal which directly or indirectly regulates a regulatable transcriptional control element.

Applicant notes that U.S. Patent Application Serial Nos. 11/220,397 and 11/276,077 have not yet issued and are pending. Therefore, a terminal disclaimer is not required in these matters until issuance of one of them. If a terminal disclaimer is required in either application for Serial Nos. 11/220,397 and 11/276,077, it can be requested by the Office before issuance of those matters.

*The 35 U.S.C. § 102 Rejection Using Soykan et al.*

Claims 1-2, 8, 13, 32-33, 39, 44, 63, 67, 71, and 73 were rejected under 35 U.S.C. § 102(b) as being anticipated by Soykan et al. (U.S. published application No. 2001/0000802).

*Claims 1 and 32*

Applicant respectfully traverses the rejection and submits that Soykan et al. do not provide the recited subject matter. For example, Applicant is unable to find in Soykan et al., among other things, a teaching or suggestion of a gene regulatory signal delivery device that emits a regulatory signal which directly or indirectly regulates a regulatable transcriptional control element, and a controller electrically connected to the gene regulatory signal delivery device, as recited in claims 1 and 32.

Applicant respectfully requests reconsideration and allowance of claims 1 and 32.

*Claims 2, 8, 13, 33, 39, 44, 63, 67, 71, and 73*

Applicant respectfully traverses the rejection. Claims 2, 8 and 13 ultimately depend on claim 1, and claims 33, 39, 44, 63, 67, 71, and 73 ultimately depend on claim 32, and claims 1 and 32 are believed to be allowable for at least the reason set forth above. Therefore, the discussion above for claims 1 and 32 is incorporated herein to support the patentability of claims 2, 8, 13, 33, 39, 44, 63, 67, 71, and 73.

Applicant respectfully requests reconsideration and allowance of claims 2, 8, 13, 33, 39, 44, 63, 67, 71, and 73.

Applicant respectfully requests reconsideration and allowance of claims 2, 8, 13, 33, 39, 44, 63, 67, 71, and 73.

*The 35 U.S.C. § 103 Rejection Using Soykan et al. and Hamm et al.*

Claims 3 and 34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soykan et al. in view of Hamm et al. (U.S. published application No. 2004/0030379).

Applicant respectfully traverses the rejection. Claim 3 is dependent on claim 1 and claim 34 is dependent on claim 32. Thus, the discussion above for claims 1 and 32 is incorporated herein to support the patentability of claims 3 and 34.

Applicant respectfully requests reconsideration and allowance of claims 3 and 34.

*The 35 U.S.C. § 103 Rejection using Soykan et al. and Darvish et al.*

Claims 9 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soykan et al. in view of Darvish et al. (U.S. published application No. 2002/0183686).

Applicant respectfully traverses the rejection. Claim 9 is ultimately dependent on claim 1 and claim 40 is ultimately dependent on claim 32. Thus, the discussion above for claims 1 and 32 is incorporated herein to support the patentability of claims 9 and 40.

Applicant respectfully requests reconsideration and allowance of claims 9 and 40.

*The 35 U.S.C. § 103 Rejection Using Soykan et al. and Donahue et al.*

Claims 10-12 and 41-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soykan et al. in view of Donahue et al. (U.S. published application No. 2002/0155101).

Applicant respectfully traverses the rejection. Claims 10-12 ultimately depend on claim 1 and claims 41-43 ultimately depend on claim 32. Thus, the discussion above for claims 1 and 32 is incorporated herein to support the patentability of claims 10-12 and 41-43.

Applicant respectfully requests reconsideration and allowance of claims 10-12 and 41-43.

*The 35 U.S.C. § 103 Rejection Using Soykan et al. and Shelton et al.*

Claims 64 and 68 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soykan et al. in view of Shelton et al. (U.S. Patent No. 5,312,453).

Applicant respectfully traverses the rejection. Claims 64 and 68 ultimately depend on claim 32. Therefore, the discussion above for claim 32 is incorporated herein to support the patentability of claims 64 and 68.

Applicant respectfully requests reconsideration and allowance of claims 64 and 68.

*The 35 U.S.C. § 103 Rejection Using Soykan et al. and Brady*

Claims 69-70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soykan et al. in view of Brady (U.S. Patent No. 5,314,430).

Applicant respectfully traverses the rejection. Claims 69-70 ultimately depend on claim 32. Therefore, the discussion above for claim 32 is incorporated herein to support the patentability of claims 69-70.

Applicant respectfully requests reconsideration and allowance of claims 69-70.

*The 35 U.S.C. § 35 Rejection Using Soykan et al.*

Claims 65-66 and 72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soykan et al.

Applicant respectfully traverses the rejection. Claims 65-66 and 72 ultimately depend on claim 32. Therefore, the discussion above for claim 32 is incorporated herein to support the patentability of claims 65-66 and 72.

Applicant respectfully requests reconsideration and allowance of claims 65-66 and 72.

*The 35 U.S.C. § 35 Rejection Using Soykan et al. and Nelson et al.*

Claims 74-78 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soykan et al. in view of Nelson et al. (U.S. published application No. 2002/0072785).

Applicant respectfully traverses the rejection. Claims 74-78 ultimately depend on claim 32. Therefore, the discussion above for claim 32 is incorporated herein to support the patentability of claims 74-78.

Applicant respectfully requests reconsideration and allowance of claims 74-78.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6912 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

STEVEN D. GIROUARD ET AL.

By their Representatives,

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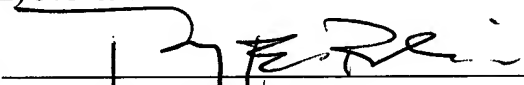
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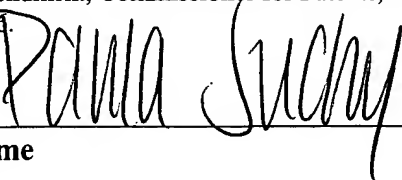
Date June 30, 2006

By

  
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of June, 2006.

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